Remarks/Arguments

Claims 1-20 are pending in this application, and are rejected in the final Office Action of June 7, 2011. No claim amendments are presented herein. However, a listing of the pending claims in the application accompanies this response for the Examiner's convenience.

Re: Patentability of Claims 1-20 under 35 U.S.C. §103(a)

Claims 1-20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Japanese Patent Publication No. 2003-132624 by Tsurui (hereinafter, "Tsurui") in view of U.S. Patent Publication No. 2002/0146238 by Sugahara (hereinafter, "Sugahara"), and further in view of U.S. Patent No. 6,469,718 issued to Setogawa et al. (hereinafter, "Setagawa"). Applicants respectfully traverse this rejection for at least the following reasons.

Independent claim 1 recites:

> "A method, comprising steps of:
> enabling a user to select a recording title stored on a digital storage medium in a first program chain for password protection, said first program chain being a single program chain according to DVD specifications;
> receiving a password from said user for said selected recording title;
> storing said password for said selected recording title on said digital storage medium in said first program chain;
> storing a password menu screen for said selected recording title on said digital storage medium in said first program chain, wherein said password menu screen prompts said user to input said password if playback of said selected recording title is attempted; and
> requiring said password to be input before playing back said selected recording title." (emphasis added)

As indicated above, independent claim 1 defines a method having a unique and distinctive combination of features in which: (i) a user-selected recording title, (ii) a user-assigned password for protecting the user-selected recording title and (iii) a password menu screen which prompts the user to input the user-assigned password if playback of

the user-selected recording title is attempted, are ***all*** stored on a digital storage medium in a ***single*** program chain according to DVD specifications. Independent claims 8 and 16 recite subject matter similar to independent claim 1, albeit in different claim formats.

None of the cited references, whether taken individually or in combination, discloses or suggests, *inter alia*, the desirability of the aforementioned combination of claim features in which: (i) a user-selected recording title, (ii) a user-assigned password for protecting the user-selected recording title and (iii) a password menu screen which prompts the user to input the user-assigned password if playback of the user-selected recording title is attempted, are ***all*** stored on a digital storage medium in a ***single*** program chain according to DVD specifications.

The primary reference, Tsurui, discloses a system in which items (i) and (iii) above are each stored on a digital storage medium in ***multiple*** program chains according to DVD specifications. In particular, Tsurui teaches the use of at least six (6) different program chains to store items (i) and (iii) above (see, for example, drawings 5(b) and (c) and their associated descriptions). In this manner, Tsurui strongly teaches away from the principles of the claimed invention in which items (i)-(iii) above are ***all*** stored on a digital storage medium in a ***single*** program chain according to DVD specifications.

The other two references, Sugahara and Setogawa, are unable to remedy the aforementioned deficiencies of Tsurui. Sugahara discloses a system in which items (i) and (ii) above are stored in a single reproduction cell (see, for example, FIG. 8 and its associated description). Setogawa discloses a system in which a "chapter menu" (which does not correspond to any of the items (i)-(iii) of the claimed invention) is stored in a single program chain. Even assuming, *arguendo*, that the "chapter menu" did somehow correspond to item (iii) of the claimed invention (which it does not), Setogawa clearly teaches that item (iii) should be placed in a single program chain (i.e., PGC 40) ***by itself*** (see, for example, column 13, lines 1-15). In this manner, Setogawa also teaches away from the principles of the claimed invention in which items (i)-(iii) above

are ***all*** stored on a digital storage medium in a ***single*** program chain according to DVD specifications.

Accordingly, in view of the foregoing discussion, even if the system of Tsurui is modified using the teachings of Sugahara and Setogawa, the resulting modification produces (at best) a system in which items (i) and (ii) are stored in one program chain, and item (iii) is stored ***separately*** in another program chain.

As such, Applicants submit that none of the cited references, whether taken individually or in combination, discloses or suggests, *inter alia*, the desirability of the aforementioned combination of claim features in which: (i) a user-selected recording title, (ii) a user-assigned password for protecting the user-selected recording title and (iii) a password menu screen which prompts the user to input the user-assigned password if playback of the user-selected recording title is attempted, are ***all*** stored on a digital storage medium in a ***single*** program chain according to DVD specifications. For this reason alone, Applicants submit that the instant rejection should be withdrawn.

Even assuming, *arguendo*, that the proposed combination of references did disclose or suggest each and every feature of the claimed invention (which it does not), Applicants submit that the claimed invention is non-obvious over the proposed combination of references for at least the following additional reasons.

On page 5 of the final Office Action of June 7, 2011, the Examiner alleges:

> "After reviewing the claims and the prior art, Examiner finds the notion of using one or more program chains moot. One of ordinary skill in the art could have used or tried any number of program chains to implement a password protected DVD as a matter of common sense." (emphasis added)

As indicated above, the Examiner ostensibly alleges that one of ordinary skill in the art could have simply arrived at the claimed invention through, for example, a process of trial and error. In other words, the Examiner ostensibly alleges that the cited

references could have been modified in a selective manner so as to arrive at the claimed invention.

In response, Applicants submit that the foregoing allegations of the Examiner are not supported by the teachings of the cited references themselves (as explained above), and therefore appear to be the result of impermissible hindsight reconstruction. For example, at least Tsurui and Setogawa teach away from the principles of the claimed invention. Applicants further note that the mere fact that a prior art device could (in hindsight) be modified to produce a claimed invention is not a basis for an obviousness rejection unless the prior art suggests the desirability of such a modification. See, for example, *In re Laskowski*, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989) ("Although the Commissioner suggests that [the structure in the primary prior art reference] could readily be modified to the form the [claimed] structure, '[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.'") and *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

In this case, Applicants submit that none of the cited references, whether taken individually or in combination, discloses or suggests the desirability of the claimed invention in which: (i) a user-selected recording title, (ii) a user-assigned password for protecting the user-selected recording title and (iii) a password menu screen which prompts the user to input the user-assigned password if playback of the user-selected recording title is attempted, are ***all*** stored on a digital storage medium in a ***single*** program chain according to DVD specifications.

Rather, as indicated above, at least Tsurui and Setogawa teach away from the principles of the claimed invention. Accordingly, it appears that the Examiner has simply identified isolated features in the prior art, and proposed combining such features in a selective manner in an attempt to meet the requirements of Applicants' claim language. Here, Applicants note that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727,

1741 (2007). Accordingly, the mere fact that isolated features of the claimed invention may have been known, independently, in the prior art, and that such features could have been combined is not sufficient to sustain an obviousness rejection.

Therefore, for at least the foregoing reasons, Applicants submit that claims 1-20 are patentable under 35 U.S.C. §103(a) over the proposed combination of Tsurui, Sugahara and Setogawa, and withdrawal of the rejection is respectfully requested.

Conclusion

For at least the foregoing reasons, it is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intention to concede any issue with regard to any claim, except as specifically stated in this paper.

Having fully addressed the Examiner's rejections, the Applicants believe this application stands in condition for allowance. Accordingly, reconsideration and allowance are respectfully solicited. If, however, the Examiner is of the opinion that such action cannot be taken, the Examiner is invited to contact the Applicants' attorney at (609) 734-6813, so that a mutually convenient date and time for a telephonic interview may be scheduled. No fee is believed due from this response. However, if a fee is due, please charge the fee to Deposit Account No. 07-0832.

Respectfully submitted,

/Reitseng Lin/
By: Reitseng Lin
Reg. No. 42,804
Phone (609) 734-6813

Patent Operations
Thomson Licensing LLC
P.O. Box 5312
Princeton, New Jersey 08540

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